

Serial No. 10/807,888

Dkt.: P-11111.00

Filing Date: March 24, 2004

Title: METHODS AND APPARATUS PROVIDING SUCTION-ASSISTED TISSUE ENGAGEMENT

**REMARKS**

Claims 1, 2, 21, 23, 24, and 26 have been amended without prejudice.

The Office Action stated claims 2-9, 23-24, 26-29, and 31-36 were allowable over the prior art. The Office Action also stated claims 2-9, 23-24, and 26-29 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Examiner is respectfully thanked for the allowed subject matter in this case.

Claims 2, 23, 24, and 26 have been amended without prejudice to include all of the limitations of the base claim and any intervening claims. Dependent claims 3-9 depend from amended independent claim 2. Dependent claims 27-29 depend from amended independent claim 26.

The Office Action stated claims 1, 10-11, 13, 16, 18-21, 25, and 30 were rejected under 35 U.S.C. 102(e) as being anticipated by Paul et al. (6,758,808).

Claim 1 has been amended without prejudice to now include the limitation that the arm vacuum lumen exhibits a vacuum leak when the articulating arm is in the flexible state, and wherein the vacuum leak is sealed as the articulating arm is changed from the flexible state to the rigid state. Claims 10-20 depend from amended claim 1. Therefore, the 102(e) rejection of claims 1 and 10-11, 13, 16, and 18-20 should be withdrawn.

Claim 21 has been amended without prejudice to now include the limitation that the arm vacuum lumen exhibits a vacuum leak when the articulating arm is in the flexible state, and wherein the vacuum leak is sealed as the articulating arm is changed from the flexible state to the rigid state. Claims 22, 25, and 30 depend from amended claim 21. Therefore, the rejection of claims 21, 25 and 30 as being anticipated by Paul et al. should be withdrawn.

The Office Action stated claims 12, 14-15, 17, and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Paul et al. (6,758,808) as applied to claims 1 and 21 above, in view of Gannoe et al. (2002/0077532 A1).

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Claim 1 has been amended without prejudice to now include the limitation that the arm vacuum lumen exhibits a vacuum leak when the articulating arm is in the flexible state, and wherein the vacuum leak is sealed as the articulating arm is changed from the flexible state to the rigid state. Claims 10-20 depend from amended claim 1. Therefore, the 103(a) rejection of claims 12, 14-15, and 17 should be withdrawn.

Claim 21 has been amended without prejudice to now include the limitation that the arm vacuum lumen exhibits a vacuum leak when the articulating arm is in the flexible state, and wherein the vacuum leak is sealed as the articulating arm is changed from the flexible state to the rigid state. Claims 22, 25, and 30 depend from amended claim 21. Therefore, the rejection of claim 22 as being unpatentable over Paul et al. in view of Ganno et al. should be withdrawn.

Support for this amendment is clearly found in the application as originally filed. No new matter is presented.

With respect to the rejections based on the prior art, applicants respectfully disagree that the claims were properly rejected over the prior art. However, applicants believe the enclosed amendment renders the issue moot. Applicants reserve the right to seek claims of the scope of the rejected claims in a continuing application and are filing this amendment in an effort to expedite prosecution.

Examination and reconsideration of the application as amended is requested. After amending claims as set forth above, claims 1-36 are pending in the application and are believed to be in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

A request for a one (1) month extension of time under 37 C.F.R. 1.136(a) has been filed with this amendment. Please charge to Deposit Account No. 13-2546 the fee of \$120.00 which is required for the one-month extension of time.

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An information disclosure statement has been filed with this amendment.

If the Examiner comes to believe that a telephone conversation may be useful in addressing any remaining open issues in this case, the Examiner is invited to contact the undersigned agent at 763-391-9867.

Please charge any required fees or credit any overpayment to Deposit Account No. 13-2546.

Date: 2/1/07

Respectfully submitted,

By \_\_\_\_\_

James R. Keogh  
Reg. No. 44,824  
MEDTRONIC, INC.  
710 Medtronic Parkway  
Minneapolis, MN 55432  
Tel. 763.391.9867  
Fax. 763.391.9668  
Customer No. 27581